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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/506,488	09/02/2004	Kenichi Fujimoto	121036-0072	1392

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EXAMINER

PENG, KUO LIANG

ART UNIT PAPER NUMBER

1712

DATE MAILED: 11/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/506,488

Applicant(s)

FUJIMOTO ET AL.

Examiner

Kuo-Liang Peng

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1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/16/06 Amendment.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-14 is/are pending in the application.
- 4a) Of the above claim(s) 15-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>See Continuation Sheet</u> . |

Continuation of Attachment(s) 6). Other: English translation of JP2000-154255.

DETAILED ACTION

1. The Applicants' amendment filed on August 16, 2006 is acknowledged.

Claim 5 is deleted. Claims 8 are amended. Claims 11-18 are added.

2. Newly submitted Claims 15-18 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Invention of Claims 1-4 and 6-10 is directed to a material, while Invention of Claim 15 is directed to a vibration-absorbable mount and invention of Claims 16-18 is directed to a cover. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, Claims 15-18 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03. Now, Claims 1-4 and 6-14 are pending for consideration.

3. Claim rejection(s) under double patenting in the previous Office Action (Paper No. 051306) is/are removed.

4. The text of those sections of Title 35, U.S. code not included in this action can be found in prior Office Action(s).

Claim Rejections - 35 USC §102 and 103

5. Rejection of Claims 1-4, 6 and 10 under 35 U.S.C. 102(b) as being anticipated by JP255 (JP 2000-154255) and rejection of Claims 7-9 under 35 U.S.C. 103(a) as being unpatentable over Bar-Lev (WO 01/33103) in view of JP255 are maintained because the rejection is adequately set forth in Paper No. 051306. The newly added Claims 11-14 are rejected over similar ground. Applicant's arguments have been fully considered but they are not persuasive. The focus argument related to the core patentability is discussed below.

It is noted that JP255 was cited in the information disclosure statement. However, Applicants did not provide the translation of whole document. A translation of JP255 is attached for Applicants/Counsel's convenience, which can be obtained from the Japanese patent office web site. JP255 (Fujita et al) does teach a curable composition comprising A) an acrylic polymer containing at least one alkenyl group, B) a **hydrosilyl group**-containing compound and a hydrosilylation catalyst. ([0005], [0078], [0086] and Examples) Applicants' primarily argue that JP255 teaches "compounding an alkenylated vinyl polymer

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and a hydrosilated compound". This statement appears to come from the abstract of JP255 provided by Applicants. However, the same abstract further teaches that the vinyl polymer and the hydrol[s]ilated compound are compounded in a molar ratio of alkenyl group to **hydrosilyl group** (i.e., Si-H) of 5-0.2". Therefore, the hydrosilated compound clearly means a compound that contains hydrosilyl groups. Therefore, Applicants' argument appears to be moot. Since JP255's composition is substantially the same as that of Applicants', both should possess the same properties, such as loss tangent, etc. Since PTO does not have proper means to conduct experiments, the burden of proof is now shifted to Applicants to show otherwise. *In re Best*, 195 USPQ 430 (CCPA 1977).

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire

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on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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klp
October 27, 2006


Kuo-Liang Peng
Primary Examiner
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